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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,894	10/30/2003	Gary W. Ramsden	331235-00019	9250
27160	7590	02/03/2006		
KATTEN MUCHIN ROSENMAN LLP 525 WEST MONROE STREET CHICAGO, IL 60661-3693			EXAMINER SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,894	Applicant(s) RAMSDEN ET AL.	
	Examiner Traci L. Smith	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77, 79 and 80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77, 79 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to papers filed on January 6, 200.
2. Claim 77 has been amended.
3. Claims 77 and 79-80 are pending.
4. Claims 77 and 79-80 are rejected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 77 recites the limitation "the package" There is insufficient antecedent basis for this limitation in the claim. The limitation is found in line 14 of claim 77 in the section for "printing means....for placement on 'the package'." Claim also recites "the cost" in line 5 of claim 77, where a cost was not identified prior to this limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 77 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,923,022; Hsieh; Automatic mailing apparatus and further in view of US Patent 5,065,000 Pusic Automated Electronic Postage Meter Having a Direct Access Bar Code Printer.

10. As to claim 77 teaches a machine for mailing envelopes

- a. Receiving payment(C. 4 I. 14-17)
- b. Scale for weighing envelope and identifying weight(C. 3 I. 35)
- c. Type of mail service available displayed(C. 4 I. 1-3).
 - i. **displays postage of the delivery option selected by the user(C. 4 I. 9-12)**
- d. User selects delivery option and enters delivery information(C. 4 I. 4-5).
- e. Computes a cost for delivery(C. 4 I. 9-11).

Hsieh teaches stamping the envelope with postage but fails to teach printing a bar code label and receipt of purchase. Pusic teaches an automated electronic postage meter with a printer that prints both bar codes and receipts. (C. 3 I. 67-68; C. 4 I. 1-4). It would have been obvious to one skilled in the art at the time of

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invention to combine the teachings of Pusic with Hsieh so as to allow for quicker delivery with the use of reading a bar code and allowing the user proof of mailing the envelop.

11. As to claim 80 Hsieh teaches the payment means as a magnetic strip credit card reader(C. 4 I. 14-17).

12. Claims 79 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,923,022; Hsieh; Automatic mailing apparatus and further in view of US Patent 5,065,000 Pusic Automated Electronic Postage Meter Having a Direct Access Bar Code Printer.as applied to claims 78 and 80 above, and further in view of US Patent 4,836,352 Tateno; Express Package Collection Locker

13. As to claim 79 Hsieh and Pusic teach an automated postage machine, however they fail to teach the input means as a touch screen. Tateno teaches a touch screen in order enter destination information(C. 5 I. 15-20). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Tateno with Hsieh and Pusic so as to have an alternative means of inputting information that can withstand the element of the environment in which the kiosk is located.

Response to Arguments

14. Applicant's arguments filed January 6, 2006 have been fully considered but they are not persuasive.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant argues that there is not suggestion either in the references or the knowledge available to "modify" the references with a printer for printing of bar codes. The examiner first addresses the argument of "knowledge available. The examiner draws applicants attention to the filing dates of the two references combined for these limitations were both filed at least two years prior to applicants "invention being made". ; thus establishing knowledge at applicants time of invention.

16. As to applicants arguments that combining the references would require modification of Hsieh by "removing" the stamping means. The examiner notes the rejection is a "combination" in which the limitation of a printing means is in addition to, not instead of, what Hsieh has already established. The examiner notes that Pusic discusses two methods of applying the bar code to the item, either by being moved along a conveyor for items less than one inch which would be the equivalent to Hsieh's stamping means inside the apparatus or the label could also be printed on a self-adhesive label to be put on outside the apparatus. (C.4 l. 43-46 and C. 6 l. 8-16). Therefore, this demonstrates that Hsieh's stamping means would not have to be eliminated for the addition of a printer to print a bar code label or a customer receipt.

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17. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and In re Nievelt, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures.").

18. As to applicants arguments regarding providing "reasonable expectation of success of the combination" the examiner notes first that applicant fails to provide evidence as to why there would not be an expectation of success for the combinations. The examiner further notes that given the motivation provided above; if one of ordinary skill would have been motivated to combine a printing means with the Hsieh mailing apparatus it is with the expectation that the combination will be successful.

19. As to applicant arguments regarding the combination of Tateno the examiner draws the applicants attention to C. 5 l. 15-20 where Tateno states that the touch screen can be used in place of input buttons rendering it an equivalent input means. The examiner notes any recognizable equivalence could be used to replace an input means with any common interface means such as a joystick, mouse, keyboard, voice recognition based on the location and intended use of the kiosk.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

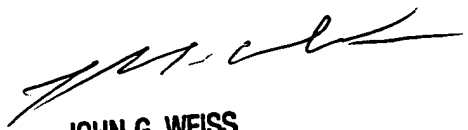
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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